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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,382	01/27/2004	Ernest J. St. Pierre	BSCU-032/02US	2525

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EXAMINER	
SNOW, BRUCE EDWARD	
ART UNIT	**PAPER NUMBER**
3738	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/22/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/765,382	ST. PIERRE, ERNEST J.	
	Examiner	Art Unit	
	Bruce E. Snow	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant's argument and amendment filed 12/01/06 have been considered. Applicant has amended the independent claims including the limitation "*the first material and the second material being distinct from each other and arranged substantially symmetrically within a plane normal to the longitudinal axis*". Regarding the rejection under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al (4,874,360) in view of Wang (6,135,992), Wang teaches many different co-extrusion configurations including the slated configuration shown in figure 8A which meets the claims language "arranged substantially symmetrically within a plane normal to the longitudinal axis". It is the Examiner's position that it is within the scope of the rejection and would have been obvious to one having ordinary skill in the art to use any of the co-extrusion configurations taught by Wang with the catheter of Goldberg et al.

Again, applicant's submission of a terminal disclaimer is noted and the appropriate personnel have been messaged for its review.

Applicant is welcomed to contact the Examiner to discuss the current application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,620,202. Although the conflicting claims are not identical, they are not patentably distinct from each other claiming the identical stent, for example, current claim 1 corresponds to claim 1 comprising a first section having a first durometer, second section having a greater second durometer, and a third section comprised of material from both the first and second material.

Claims 10-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,719,804. Although the conflicting claims are not identical, they are not patentably distinct from each other claiming the identical stent, for example, current claim 1 corresponds to claim 18 comprising a first section having a first durometer, second section having a greater second durometer, and a third section comprised of material from both the first and second material.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10 and 12-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al (4,874,360) in view of Wang (6,135,992).

Goldberg et al discloses a medical device comprising:

a first section 12 including a retention structure comprising a first material having a first durometer value;

a second section 11 including a second retention structure comprising a second material having a second durometer value higher than the first (see column 2, lines 53-60);

and a third section location between said first and second sections shown in figure 6. However, Goldberg fails to teach the third section comprises a co-extrusion of the first and second materials forming the third section.

Wang teaches a similar device for use in various body lumens comprising a first section comprising a first material having a first durometer value and a second section comprising a second material having a second durometer value higher than the first and further teaches a third section, i.e. 19, which is a co-extrusion of the first and second materials.

It would have been obvious to one having ordinary skill in the art to have utilized the teaching of Wang to form the medial device of Goldberg having a co-extruded third section of the first and second materials which are distinct and associated in an irregular configuration because:

"this type of differential stiffness catheter is usually made by hand by joining two or more pieces of tubing together, they are labor intensive and therefore expensive to manufacture. Moreover, these catheters tend to buckle and to kink at the joints where there occurs an abrupt change in stiffness. Buckling and kinking are very undesirable characteristics for catheters. Also, there is a tendency for the joints to separate leaving the tip of the catheter inside the body and requiring surgery to retrieve it." See 1:60 et seq. of Wang.

And, the "co-extruded, e.g., "wedged into" one another to produce an extremely secure, practically non-breakable joint between the two materials. The merging of the two materials is very smooth and gradual to eliminate the buckling and kinking that usually occurs at abrupt joints between two materials of different stiffness." See 3:12 et seq. of Wang.

Regarding claim 21, higher durometer produces a higher retention strength and vise versa.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al (4,874,360) in view of Wang (6,135,992).

Goldberg et al and Wang teaches the medical stent as described above, however, are silent regarding ethylene vinyl acetate. Said material is well known in the art for stents and it would have been obvious to one having ordinary skill in the art to have utilized it for the stent of Goldberg et al for its know characteristics including biocompatibility.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

bes

BRUCE SNOW
PRIMARY EXAMINER